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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/26/1947 07/27/99 SUMMER

C 05015.0289

EXAMINER

HM12/1003

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
SUITE 600  
100 NEW YORK AVENUE N.W.  
WASHINGTON DC 20005-3934

MURRAY, J

ART UNIT

PAPER NUMBER

1626

DATE MAILED:

10/03/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/360,947

Applicant(s)

Sumner, C.

Examiner

Joseph Murray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 19, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s): \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s): \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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Claims 1-47 are pending in the instant application, which is an CPA filed on 9/19/01. No claims have been canceled, added, or amended in the instant application.

### ***Double Patenting***

Claims 1-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of Sumner et al, USPN 6159347, and sumner et al, USPN 6224717, and claims 1-67 of and Sumner et al, USPN 6224717. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application claims the separation of a tocolpherol from a tocolpherol admixture the tocolpherol generic form of the compound, and the copending application claims the separation of a tocotrienol, or tocol from a tocol mixture, which is an isomeric/unsaturated form of the tocols. The only difference of the instant application from the references is the desired product of the separation process, all being within the same class of compound, e.g alkyl/alkenyl substituted hydroxy-benzopyrans. Therefor one of ordinary skill in the art would have been motivated to apply the instantly claimed invention to the other isomers of the tocols. Thus it would have been obvious to one of ordinary skill in the art to apply the method of separation in references to the tocol separation by only modifying the extraction solvent selection.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-47 are rejected under 35 U.S.C. 103(a) as being obvious over claims 1-60 of Sumner et al, USPN 6159347, and sumner et al, USPN 6224717, and claims 1-67 of and Sumner et al, USPN 6224717 which has a common inventor, e.g. Charles E. Sumner Jr., with the instant application. Based upon the earlier effective U.S. filing date of the references, it would constitute prior art under 35 U.S.C. 102(e). Although the conflicting claims are not identical, they are not patentably distinct from each other because while the instant application claims the separation of a tocolpherol from a tocolpherol admixture the tocolpherol generic form of the compound, and the references claim the separation of a tocotrienol, or tocol from a tocol mixture, which is an isomeric/unsaturated form of the tocols. The only difference of the instant application from the references is the desired product of the separation process, all being within the same class of compound, e.g alkyl/alkenyl substituted hydroxy-benzopyrans. Therefor one of ordinary skill in the art would have been motivated to apply the instantly claimed invention to the other isomers of the tocols. Thus it would have been obvious to one of ordinary skill in the art to apply the method of separation inreferences to the tocol separation by only modifying the extraction solvent selection.

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This rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the references under 37 CFR 1.131.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-47 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. Although the instantly claimed applicant is a named inventor in the references, *supra*, there are several other inventors in the copending applications, which have rights to the instantly claimed invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Soseph Murray whose telephone number is (703) 308-4540. The examiner can normally be reached on Monday-Friday from 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

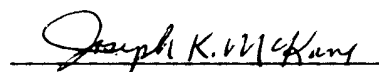
When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-

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mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

A handwritten signature in cursive script, reading "Joseph K. McKane", is written over a horizontal line.

Joseph McKane  
Supervising Patent Examiner  
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Joseph Murray  
October 1, 2001